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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/825,337	04/04/2001	Toshio Yagihashi	Q63928	1780

7590 07/16/2003  
SUGHRUE, MION, ZINN, MACPEAK & SEAS  
2100 Pennsylvania Avenue, N.W.  
Washington, DC 20037-3202

EXAMINER
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O CONNOR, GERALD J

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 07/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/825,337

Applicant(s)  
Yagihashi et al.

Examiner  
O'Connor

Art Unit  
3627



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on May 6, 2003 (Amendment "A").
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above, claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on April 4, 2001 is/are a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some\* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                              | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ | 6) <input type="checkbox"/> Other:  |

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## **DETAILED ACTION**

### ***Preliminary Remarks***

1. This Office action has been prepared in response to the amendment and arguments filed by applicant on May 6, 2003 (Paper N<sup>o</sup> 4).
2. The amendment of claims 1-8 by applicant in Paper N<sup>o</sup> 4 is hereby acknowledged.
3. The addition of claims 9-15 by applicant in Paper N<sup>o</sup> 4 is hereby acknowledged.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tavor et al. (US 6,070,149), in view of Bezos et al. (US 6,029,141).

Tavor et al. disclose a commercial sales method and system, comprising: registering in advance a specific-item catalog and a relevant-item catalog in a home page on the WWW (see, in

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particular, column 16, lines 17-37, and Figure 11); a purchaser viewing the specific-item and relevant-item catalogs on the home page via a network by means of a terminal, and sending a purchase request to a relevant-item seller selling the items relevant to the specific item designating one of the relevant items; the relevant-item seller delivering the purchased item to the purchaser in accordance with the purchase request; and, the relevant-item seller informing a settlement computer of sales data of the purchased item, wherein the specific-item catalog and the relevant-item catalog each comprise information about the item (item description) in addition to a link, but in the method and system of Tavor et al., one seller sells both the specific item and the relevant item, rather than one seller selling the specific item and a separate seller selling the relevant item.

However, Bezos et al. disclose a similar commercial sales method and system, and Bezos et al. indeed disclose two separate sellers working together, with the seller actually selling the product paying a commission to the other seller whose WWW home page generated the sale.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method and system of Tavor et al. so as to utilize two sellers working together rather than one unitary seller, in accordance with the teachings of Bezos et al., in order to generate increased sales by attracting a larger customer base by offering a greater number and selection of products for customers, particularly specialty/low-volume products, without having to incur additional inventory/carrying costs.

Regarding claims 2-3, 6-7, 10-11, and 15, the method and system of Tavor et al. keeps track of the purchase history of the purchaser (see, in particular, column 40, line 61 et seq.), but

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since there is no second seller, Tavor et al. disclose neither requesting permission from the purchaser to divulge the purchase history to the other seller, nor reducing the commission paid to the other seller with reference to the purchaser history data. However, asking permission to divulge a purchaser's history data and reducing the amount of commission paid for subsequent referrals after an initial referral are both well known, hence, obvious steps to follow in an online commercial sales method and system. Therefore, it would have been obvious to further modify the method and system of Tavor et al. so as to ask permission of the purchaser to divulge the purchase history of the purchaser to the other seller and pay the other seller less commission based on the purchase history, as is well known to do, in order to appease customer's privacy concerns and compensate referral sales in accordance with their value (i.e. pay less for subsequent referrals because a customer is more likely to return to a site once he knows about the site and has done business there), since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Regarding claims 4, 8, and 12-13, the method and system of Tavor et al. includes sending the relevant-item seller a request for discounting the item designated for purchase and the relevant-item seller sending the purchaser an acceptance of the request, wherein the purchaser purchases the item for the discounted price after the purchaser receives the acceptance of the discount. See, in particular, column 14, lines 1-9, and Figure 7, block 98, the presentation to the seller by the purchaser of a coupon being considered "a request for a discount."

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***Response to Arguments***

6. Applicant's arguments filed May 6, 2003 have been fully considered but they are not persuasive.

7. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine the references would be to generate increased sales by attracting a larger customer base by offering a greater number and selection of products for customers, particularly specialty/low-volume products, without having to incur additional inventory/carrying costs.

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to the disclosure.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, Jerry O'Connor, whose telephone number is (703) 305-1525, and whose facsimile number is (703) 746-3976.

GJOC



July 8, 2003



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